

JAW

PATENT
P56904

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOON-YOUNG PARK *et al.*

Serial No.: 10/670232

Examiner: ELIZABETH A. BIELLEY

Filed: 26 September 2003

Art Unit: 2879

For: POLYMER ORGANIC LIGHT EMITTING DIODE

PETITION UNDER 37 CFR §1.181

Paper No. 6

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the first Office action (Paper No. 2005252005) mailed 28 June 2005, entry and consideration of the following timely filed petition is respectfully requested.

Folio: P56904
Date: 7/20/05
I.D.: REB/kf

STATEMENT OF FACTS

1. On 28 June 2005, the Examiner mailed a first Office action (Paper No. Paper No. 2005252005). In Paper No. Paper No. 2005252005, the Examiner required labeling Figures 1A and 1B "Prior Art".
2. Three copies of Decisions on Petition for the following references previously issued by Group Directors to reverse similar requirements by other Examiners to label drawings "Prior Art", are enclosed:
 - Paper No. 21 issued on 25 February 1998 for U.S. Application Serial No. 08/447,279 filed on 22 May 1995;
 - Paper No. 15 issued on 2 October 1996 for U.S. Application Serial No. 08/343,939 filed on 17 November 1994; and
 - Paper No. (unknown) issued on 15 December 1999 for U.S. Application Serial No. 08/985,544 filed on 5 December 1997.

ARGUMENTS AND/OR REMARKS

In Paper No. Paper No. 2005252005, the Examiner erroneously maintained the objection on Figures 1A and 1B to be labeled as “Prior Art”. The Examiner states:

“Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated.”

Manual of Patent Examining Procedure (MPEP) §608.02(g) states:

“Figures showing the prior art are usually unnecessary and should be cancelled, *Ex parte Elliott*, 1904 C.D. 103, 109 O.G. 1337 (Comm’r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as “Prior Art.”

If the prior art figure is not labeled, form paragraph 6.36.01 may be used.

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. (*See* MPEP §608.02(g).”

Applicant has explained that Figures 1A and 1B are not “Prior Art”.

First, in Paper No. Paper No. 2005252005, the Office action dated 28 June 2005, the Examiner asserted that “Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated” and cited §608.02(g) of the *Manual Patent Examining Procedure* (MPEP). The term “Prior Art” is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term “Prior Art” by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102, however, states that subject

matter “which is *old*” constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. Paper No. 2005252005. In short, the age of the subject matter does not convert that subject matter into prior art, as the term “prior art” is defined by the law of the United States. Consequently, the Examiner’s sole rationale for imposing the requirement that Figures 1A and 1B be labeled as “Prior Art” is contrary to statute and improper. The requirement must be therefore be withdrawn.

Second, Figures 1A and 1B are not themselves believed to constitute “Prior Art” as that term is defined by either 35 U.S.C. §102 or 35 U.S.C. §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant’s belief or establish that Figures 1A and 1B constituted *prior art*, as that term is defined by statute. As evidenced from the Declaration/Oath, the Applicant is a citizen of Republic of Korea, and, as such, devised Figures 1A and 1B in Korea in order to illustrate Applicant's discovery of problems plagued in the art. Therefore, since there is no showing that Figures 1A and 1B were known to anyone other than the Applicant *in this country* nor is there a showing that Figures 1A and 1B were *patented or published in this country or a foreign country*, then Figures 1A and 1B can not be deemed to be “Prior Art” absent evidence to the contrary.

Third, Figures 1A and 1B are simply abstract representations of the art prepared by the Applicant in an effort to illustrate Applicant's discovery of problems plagued in the art in accordance with 37 C.F.R. §1.83(b); this discovery is itself, together with Applicant's


abstraction of the art represented by Figures 1A and 1B, part of the Applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g).

REMEDY REQUESTED

In view of the above, the Commissioner is respectfully requested to:

- A. Withdraw the requirement to label Figures 1A and 1B as "Prior Art";
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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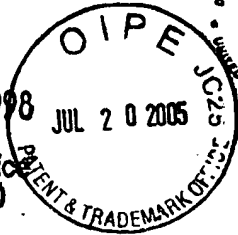
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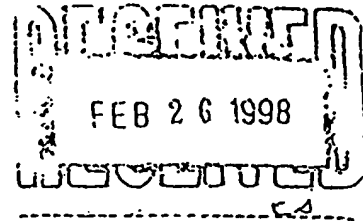
Director's Office
Group 2700



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 21

Robert E. Bushnell
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In re Application of)
Gwon-Il Kim)
Application Serial No.)
08/447,279)
Filed: May 22, 1995)
For: SERVO CONTROLLER)
APPARATUS AND METHOD)
OF DISK RECORDING)
SYSTEM)

DECISION ON RENEWED
PETITION UNDER
37 C.F.R. § 1.181

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

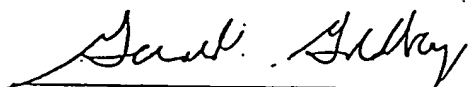
There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

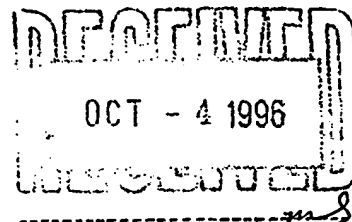


Gerald Goldberg, Director
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P53116



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231



In re Application of
MYUNG-CHAN JEONG
Serial No: 08/343,939
Filed on : November 17, 1994
For : DIGITAL SERVO CONTROL
APPARATUS AND METHOD
OF DATA STORAGE SYSTEM
USING DISK RECORDING
MEDIA

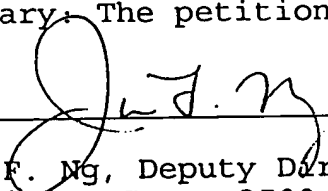
DECISION ON PETITION
UNDER 37 CFR 1.181

This is a decision on the petition filed on September 13, 1996 requesting the withdrawal of the requirement to label Fig. 3 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally filed and discussed was referred to as "CONVENTIONAL". Hence, in keeping with the disclosure and petitioner's arguments, the examiners' requirement to label this figure as "Prior Art" is incorrect and withdrawn.

Summary: The petition is Granted.


Jin F. Ng, Deputy Director
Examining Group 2500
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GROUP 2500

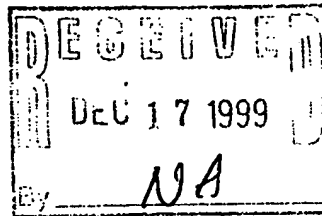
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Group 3600



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ROBERT E BUSHNELL
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In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT
DISPLAY DEVICE

PS4947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is **GRANTED**.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues.
1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

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PATENT
P56904

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JOON-YOUNG PARK *et al.*

Serial No.: 10/670232

Examiner: ELIZABETH A. BIELLEY

Filed: 26 September 2003

Art Unit: 2879

For: POLYMER ORGANIC LIGHT EMITTING DIODE

TRANSMITTAL OF SUBSTITUTE FORMAL FIGURE(S)

Paper No. 7

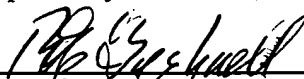
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This transmittal accompanies the Substitute Formal Figures 1A and 1B for the above-captioned application. The accompanying Figures 1A and 1B incorporate drawing corrections required by the Examiner in the Office action mailed on 28 June 2005, namely labeling of Figures 1A and 1B as "Prior Art".

Note however that Applicant filed a Petition requesting withdrawal of the aforesaid requirement on 20 July 2005. Accordingly, entry of the substitute formal drawings Figures 1A and 1B submitting herewith is respectfully requested to be contingent **only** upon final denial of Applicant's Petition filed on 20 July 2005.

Respectfully submitted,


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Date: 7/20/05
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FIG. 1A (PRIOR ART)

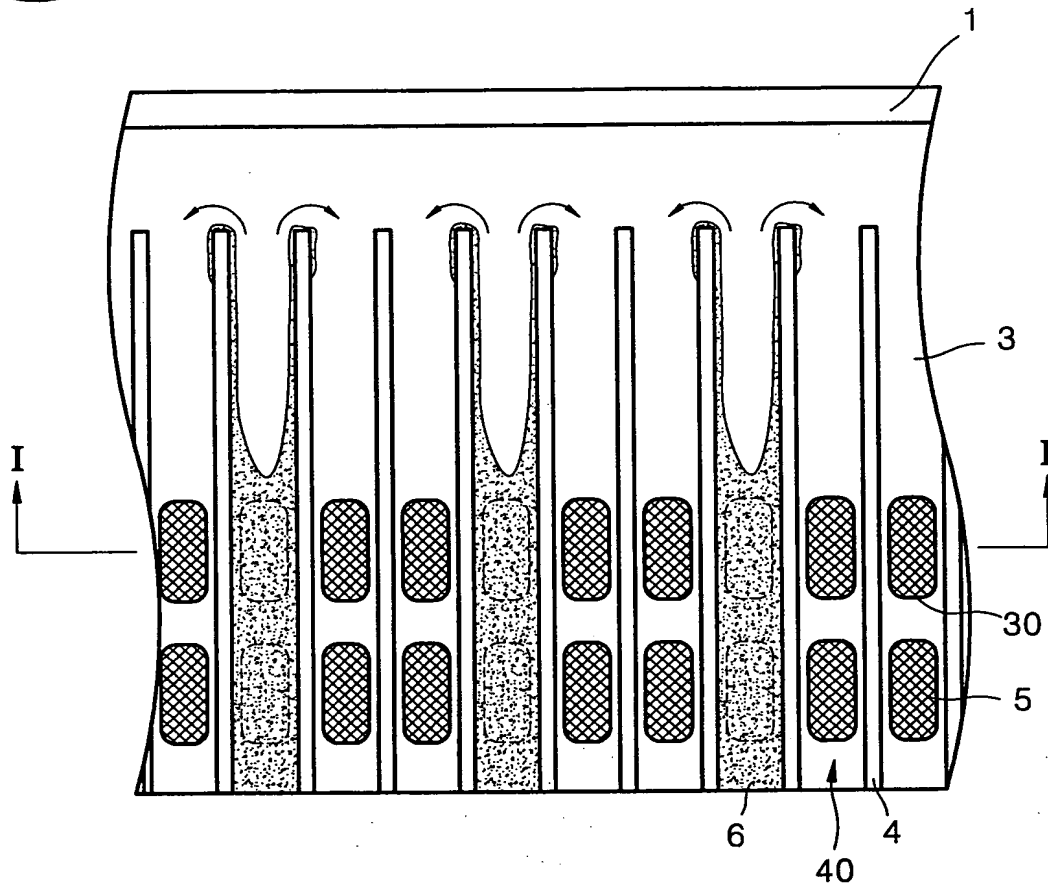


FIG. 1B (PRIOR ART)

